

REMARKS

Originally filed claims 1-24 were canceled by preliminary amendment. No claims are canceled herein. Claims 25-58 were added by preliminary amendment. No new claims have been added herein. Therefore, claims 25-58 are pending. No claim has been amended herein. Claims 25-58 are subject to a restriction requirement.

Examiner Interviews

Applicant appreciates the opportunity afforded by Examiner Chang to discuss the pending claims and restriction thereof. Applicant, however, notes that the Examiner's Interview summary incorrectly reflects that Lawrence Villanueva, attorney, was present in the Interviews of January 11, 2007, and January 30, 2007. Instead, Kevin W. Hathcock (Registration No. 52,998) was present as Agent for Applicant. Correction of the record is respectfully requested.

Invention Disclosure Statement

Applicant further notes that an Information Disclosure Statement (IDS) with attached Form PTO-1449 was submitted June 22, 2005; however, no acknowledgement of same has been made of record. It is assumed the Examiner will consider this IDS in the next Office Action, when the application is considered substantively.

Restriction Requirement

In the Restriction Requirement, the Examiner requires Applicant to elect a single invention for prosecution on the merits from one of two patentably distinct inventions. The Examiner contends that these two patentably distinct inventions are those of:

Group I: Claims 25-35 and 37, drawn to a foamed material.

Group II: Claims 36 and 38-58, drawn to a process of making a foamed material.

Applicant hereby provisionally elects Group I, as set forth in claims 25-35 and 37, with

traverse. However, Applicant respectfully requests that the restriction requirement be reconsidered and withdrawn for at least two reasons:

- **The Restriction Requirement does not comply with M.P.E.P § 803**

Without conceding that the claims in the various Groups are not patentably distinct, Applicant respectfully asserts that the Action has not shown that a serious burden would be required to examine all of the pending claims of Groups I and II in the this application. Specifically, M.P.E.P § 803 provides:

If the search and examination of an application can be made without serious burden, the Examiner *must* examine it on the merits, even though it includes claims to distinct or independent inventions.
(*Emphasis supplied.*)

Thus, for a restriction to be proper, the Office Action must satisfy the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. § 121); and (2) that the search and examination of the entire application cannot be made without serious burden. *See* M.P.E.P § 803.

The Office Action has not shown that the second requirement has been met. Specifically, the Office Action has not shown that it would be a serious burden to search and examine all of the groups together. Indeed, the Office Action has not even alleged that it would be a serious burden to search and examine all of the groups together. Consequently, reconsideration and modification or withdrawal of the restriction is requested.

- **The Action does not meet its burden for establishing lack of unity of invention**

Without conceding that the claims in the various Groups are not patentably distinct, Applicant respectfully asserts that the Restriction Requirement does not meet the requisite burden for establishing a lack of unity of invention. Specifically, 37 C.F.R. § 1.475 provides that national stage applications shall relate to one invention or to a group of inventions so linked as to

form a single general inventive concept. Such inventions possess unity of invention. PCT Rule 13.2 states that

[T]he requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Thus, the requirement of a single inventive concept is fulfilled when there is a technical relationship within the claimed subject matter involving one or more of the same or corresponding special technical features, which define a contribution that the claimed subject matter makes over the prior art. Additionally, MPEP 1850 states that contributions over the prior art “should be considered with respect to novelty and inventive step.”

Applicant respectfully disagrees with the Action’s statement that claim 25 is either anticipated or obvious over DiSimone et al. (US 5,840,820). To the contrary, the pending claims are patentable over the cited reference. More specifically, DiSimone et al. disclose reaction in an extended CO₂ phase, which CO₂ phase can at best be compared with the continuous fluid K1 of the invention of the present application as it represents the external phase. According to the invention of the present application, CO₂ is contemplated as the internal fluid K2, which is present in pools. The system of the invention of the present application represents the inverse system relative to the system of DeSimone et al., and consequently the system of the present application is neither anticipated nor rendered obvious by the teaching of DiSimone et al.

The Action at page 2 has alleged that “DiSimone teaches olefin metathesis reactions in carbon dioxide medium in the presence of an amphiphilic [sic] material, which reads on K1, K2, and K3 of claim 25.” Applicant respectfully points out, as set forth above, that this allegation is an incorrect reading of DiSimone et al. vis-à-vis the pending claims. Thus, the Action has failed to provide any evidence that any disclosure exists in the art that would destroy the novelty or inventive step of this common technical feature and thereby destroy the inventive concept. Thus,

the Action does not meet the requisite burden for establishing a lack of unity of invention. Accordingly, Applicant submits that all of the pending claims possess unity of invention and, therefore, request reconsideration and modification or withdrawal of the restriction.

Election of Species

The Office Action also alleges that the application contains claims directed to more than one category of species of the generic invention. Also, the Action alleges that claim 25 is generic for Group I and that claim 36 is generic for Group II. The Action requires election of a species from each of three categories, as recited below:

- | | |
|------|---|
| I: | Amphiphilic Material (claims 34 and 35) |
| II: | Second Fluid (claim 33 and 35) |
| III. | First Fluid (28-32 and 35) |

As set forth in the immediately preceding section, without conceding that the claims in the various Groups are not patentably distinct, Applicant asserts that the Action has not met its requisite burden. Nonetheless, Applicant provisionally elects the species as set forth below:

- | | | |
|------|---|-------------------------|
| I: | Amphiphilic Material (claims 34 and 35) | “non-ionic surfactants” |
| II: | Second Fluid (claim 33 and 35) | “hydrocarbons” |
| III. | First Fluid (28-32 and 35) | “polar substances” |

Further, to the extent that election of a species for the polymerizable substance of claim 30 and 32 is required, Applicant provisionally elects “acryl amide.”

The claims readable on “nonionic surfactants” are 25, 34-36, and 54-56. The claims readable on “hydrocarbons” are 25, 27, 33, 35-36, 38-45, 53, and 55-56. The claims readable on “polar substances” are 25-29, 31, 35-38, 45-47, 49, and 55-56. The claims readable on “acryl amide” are 29-32 and 47-50. Applicant notes that, upon allowance of a generic claim, Applicant will be entitled to consideration of additional species that are written in dependent form or otherwise include all limitations of an allowed generic claim, as provided by 37 C.F.R. 1.141.


CONCLUSION

Applicant awaits an action on the merits. Should the Examiner have any questions regarding this response, the Examiner is encouraged to contact the undersigned at the telephone number and address listed below.

A one-month statutory period was set for response nominally ending February 22, 2007. Also enclosed herewith is a Request for Four-Month Extension of Time, which extends the due date to June 22, 2007. Therefore, this paper is timely.

Payment in the amount of \$795.00 for the Four-Month Extension of Time for a small entity is enclosed herewith. The payment is to be charged to a credit card and is authorized by the signed, enclosed document entitled: Credit Card Payment Form PTO-2038. No further fee is believed due. However, the Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,
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CERTIFICATE OF MAILING

I hereby certify that this correspondence and any documents referenced herein as being enclosed herein are being deposited with the United States Postal Service in an envelope addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the date below.



Mitchell A. Katz

June 21, 2007

Date